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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/665,511

09/22/2003

Douglas A. Beigel

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10/03/2008

NATH & ASSOCIATES
112 South West Street
Alexandria, VA 22314

EXAMINER

UTAMA, ROBERT J

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

10/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/665,511	Applicant(s) BEIGEL, DOUGLAS A.	
	Examiner ROBERT J. UTAMA	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of the application

1. This office action is a response to the amendment and argument filed on 06/12/2008. The current status of the claims in the application is as follow: claims 1-13 and 18-27 are still pending and claims 14-17 have been cancelled.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11-13, 18-21 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order to be considered patent eligible under 35 USC 101, a claimed process must contain a sufficient tie to a machine, article of manufacture or a composition of matter. *In re Comiskey*, 84 USPQ2d 1670 (Fed. Cir. 2007). In this case, the claimed invention does not have a sufficient tie to any machine, article of manufacture or a composition of matter. In this particular case, the claimed method do not set forth any ties to any other statutory subject matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1, 8, 11, 22 and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Singer US 6,557,009.**

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Claim 1, 11 and 22: The Singer reference database storing a plurality of evaluation question and plurality of assessment question (see col. 5:55-68); wherein the evaluation question ask for information usable to construct a profiles of at least one organization (see col. 9:20-30); wherein the assessment question ask for information usable to construct profiles of at least one organization (see col. 8:1-15); wherein subsets of said plurality of evaluation and assessment question are combinable to form a plurality of assessment courses (see col. 10:33-40); a server connected to said database via communication network having a processor configured to cause a graphical user interface to be displayed to a network access device connected to said server via said communication network (see FIG 1 item 13, 14, 19); wherein said processor is further configured to present to an assessed user as an individual personnel of an organization seeking one compliance certification via said graphical user interface, a subset of evaluation comprised by at least one of said plurality of assessment course (see col. 9:20-30) wherein said processor is further configured to received responses from the assess user to said subset of evaluation question (see 10:33-40); the processor is further configured to construct at least one profile of the organization seeking said at least one compliance certification based on said responses to said subset of evaluation question (see FIG 3Ci); wherein said processor is further configured to present to the assessed user via said graphical user interface a subset of assessment question comprised by said at least one of said assessment courses and corresponding to said at least one profile of the organization seeking said compliance certification (see FIG 3F) and wherein said processor is further configured to receive responses from the assessed user to the subset of assessment question comprising said at least one of said plurality of assessment question (see col.).

Claim 8 and 21: The Singer reference provides a teaching where the communication network is at lest a portion of the global, public internet (see FIG 1 item 13).

Claim 25 and 26: The Singer reference provides a teaching where the score the responses to said assessment question to dertermin whether the organization seeking said at least one

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compliance certification at least in part meets the requirement for said at least one compliance certification (see col. 9:60-10-5).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 2-7, 12-13, 19, 24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singer US 6,557,009. in view of Bua 2003/0167187.**

Claim 2 and 23: The Singer reference fail to produce a teaching of a first plurality of minimum scores stored in said database each corresponding to one the subset of evaluation question comprised by each of said plurality of assessment course. However, the Bua reference provides a teaching of a first plurality of minimum scores stored in said database each corresponding to one the subset of evaluation question comprised by each of said plurality of assessment course (see paragraph 59 and Table 1 "substantial compliance ..."). Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention to include the feature of a first plurality of minimum scores stored in said database each corresponding to one the subset of evaluation question comprised by each of said plurality of assessment

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course, as taught by Bua, in order to objectively judge the quality of the compliance (see paragraph 10-11).

Claim 3: The Singer reference fail to produce a teaching of a second plurality of minimum scores stored in said database each corresponding to one the subset of evaluation question comprised by each of said plurality of assessment course. However, the Bua reference provides a teaching of a second plurality of minimum scores stored in said database each corresponding to one the subset of evaluation question comprised by each of said plurality of assessment course (see paragraph 59 and Table 1 "No actual harm ..."). Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention to include the feature of a second plurality of minimum scores stored in said database each corresponding to one the subset of evaluation question comprised by each of said plurality of assessment course, as taught by Bua, in order to objectively judge the quality of the compliance (see paragraph 10-11).

Claim 4: The Singer reference fails to provide a teaching of calculating a first score based on said response to the subset of plurality of evaluation question comprised by said at least one of said plurality of assessment course. The Bua reference provides a teaching of calculating a first score based on said response to the subset of plurality of evaluation question comprised by said at least one of said plurality of assessment course (see paragraph 52). Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention to include the feature of calculating a first score based on said response to the subset of plurality of evaluation question comprised by said at least one of said plurality of assessment course, as taught by Bua, in order to objectively judge the quality of the compliance (see paragraph 10-11).

Claim 5: The Singer reference fails to provide a teaching of calculating a second score based on said response to the subset of plurality of evaluation question comprised by said at least one of said plurality of assessment course. The Bua reference provides a teaching of

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calculating a second score based on said response to the subset of plurality of evaluation question comprised by said at least one of said plurality of assessment course (see paragraph 57). Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention to include the feature of calculating a first score based on said response to the subset of plurality of evaluation question comprised by said at least one of said plurality of assessment course, as taught by Bua, in order to objectively judge the quality of the compliance (see paragraph 10-11).

Claim 6 and 7: The Singer reference fail to provide a teaching where the first and second score is equal or exceeds one of said first and second plurality of minimum scores corresponding to the subset of said plurality of assessment question comprised by said at least onf said plurality of assessment courses. However, the Bua reference provides a teaching of the first and second score is equal or exceeds one of said first and second plurality of minimum scores corresponding to the subset of said plurality of assessment question comprised by said at least onf said plurality of assessment courses (see paragraph 59). Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of the first and second score is equal or exceeds one of said first and second plurality of minimum scores corresponding to the subset of said plurality of assessment question comprised by said at least onf said plurality of assessment courses, as taught by Bua, in order to objectively judge the quality of the compliance (see paragraph 10-11).

Claim 12: The Singer reference fail to produce a teaching of a first plurality of minimum scores stored in said database each corresponding to one the subset of evaluation question comprised by each of said plurality of assessment course. However, the Bua reference provides a teaching of a first plurality of minimum scores stored in said database each corresponding to one the subset of evaluation question comprised by each of said plurality of assessment course (see paragraph 59 and Table 1 "substantial compliance ..."). Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention to include the

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feature of a first plurality of minimum scores stored in said database each corresponding to one the subset of evaluation question comprised by each of said plurality of assessment course, as taught by Bua, in order to objectively judge the quality of the compliance (see paragraph 10-11).

The Singer reference fail to produce a teaching of a second plurality of minimum scores stored in said database each corresponding to one the subset of evaluation question comprised by each of said plurality of assessment course. However, the Bua reference provides a teaching of a second plurality of minimum scores stored in said database each corresponding to one the subset of evaluation question comprised by each of said plurality of assessment course (see paragraph 59 and Table 1 "No actual harm ..."). Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention to include the feature of a second plurality of minimum scores stored in said database each corresponding to one the subset of evaluation question comprised by each of said plurality of assessment course, as taught by Bua, in order to objectively judge the quality of the compliance (see paragraph 10-11).

Claim 13: The Singer reference fails to provide a teaching of calculating a first score based on said response to the subset of plurality of evaluation question comprised by said at least one of said plurality of assessment course. The Bua reference provides a teaching of calculating a first score based on said response to the subset of plurality of evaluation question comprised by said at least one of said plurality of assessment course (see paragraph 52). Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention to include the feature of calculating a first score based on said response to the subset of plurality of evaluation question comprised by said at least one of said plurality of assessment course, as taught by Bua, in order to objectively judge the quality of the compliance (see paragraph 10-11).

The Singer reference fails to provide a teaching of calculating a second score based on said response to the subset of plurality of evaluation question comprised by said at least one of

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said plurality of assessment course. The Bua reference provides a teaching of calculating a second score based on said response to the subset of plurality of evaluation question comprised by said at least one of said plurality of assessment course (see paragraph 57).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention to include the feature of calculating a first score based on said response to the subset of plurality of evaluation question comprised by said at least one of said plurality of assessment course, as taught by Bua, in order to objectively judge the quality of the compliance (see paragraph 10-11).

The Singer reference fail to provide a teaching where the first and second score is equal or exceeds one of said first and second plurality of minimum scores corresponding to the subset of said plurality of assessment question comprised by said at least onf said plurality of assessment courses. However, the Bua reference provides a teaching of the first and second score is equal or exceeds one of said first and second plurality of minimum scores corresponding to the subset of said plurality of assessment question comprised by said at least onf said plurality of assessment courses (see paragraph 59). Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of the first and second score is equal or exceeds one of said first and second plurality of minimum scores corresponding to the subset of said plurality of assessment question comprised by said at least onf said plurality of assessment courses, as taught by Bua, in order to objectively judge the quality of the compliance (see paragraph 10-11).

Claim 19: The Singer reference fails to wherein a weight is assigned to each of plurality of responses to the subset of said plurality of assessment question comprising said at least one of said plurality of assessment of course, said weight being relative to other of said plurality of response based on compliance with at least one goal of said certification. The Bua reference provides a teaching a weight is assigned to each of plurality of responses to the subset of said plurality of assessment question comprising said at least one of said plurality of assessment of

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course, said weight being relative to other of said plurality of response based on compliance with at least one goal of said certification (see paragraph 54). Therefore, it would have been obvious to one of ordinary skilled in the art a weight is assigned to each of plurality of responses to the subset of said plurality of assessment question comprising said at least one of said plurality of assessment of course, said weight being relative to other of said plurality of response based on compliance with at least one goal of said certification, as taught by Bua, in order to objectively judge the quality of the compliance (see paragraph 10-11).

Claim 24: The Singer reference fails to provide a teaching of calculating a score based on said response to the subset of plurality of evaluation question comprised by said at least one of said plurality of assessment course. The Bua reference provides a teaching of calculating a score based on said response to the subset of plurality of evaluation question comprised by said at least one of said plurality of assessment course (see paragraph 57). Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention to include the feature of calculating a first score based on said response to the subset of plurality of evaluation question comprised by said at least one of said plurality of assessment course, as taught by Bua, in order to objectively judge the quality of the compliance (see paragraph 10-11).

The Singer reference fail to provide a teaching where the first and second score is equal or exceeds one of said first and second plurality of minimum scores corresponding to the subset of said plurality of assessment question comprised by said at least onf said plurality of assessment courses. However, the Bua reference provides a teaching of the first and second score is equal or exceeds one of said first and second plurality of minimum scores corresponding to the subset of said plurality of assessment question comprised by said at least onf said plurality of assessment courses (see paragraph 59). Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of the first and second score is equal or exceeds one of said first and second plurality of minimum scores corresponding to

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the subset of said plurality of assessment question comprised by said at least one said plurality of assessment courses, as taught by Bua, in order to objectively judge the quality of the compliance (see paragraph 10-11).

Claim 27: The Singer reference provides a teaching where the score the responses to said assessment question to determine whether the organization seeking said at least one compliance certification at least in part meets the requirement for said at least one compliance certification (see col. 9:60-10-5).

8. **Claim 9-10 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Singer US 6,557,009.**

Claim 9-10, and 18: The Fletcher reference does not provide a teaching wherein each of the responses from the assessed user to the subset of plurality of assessment question comprising said at least one of the plurality courses is indicative of "Yes" and "No" and the Fletcher reference does not provide a teaching where each of the responses from the assessed user to the subset of plurality of assessment question comprising at least one of assessment course is indicative of one of the following "Yes", "No" and "Not Applicable". Instead, the Fletcher reference provides a teaching wherein each of the responses from the assessed user to the subset of plurality of assessment question comprising said at least one of the plurality course in the form of multiple choice (see FIG. 6).

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to choose between the multiple choice as disclosed by Fletcher and "Yes" and "No" binary (and "Yes", "No" and N/A) choices as claimed by the applicant. One of ordinary skill in the art would have been expected the multiple choice form of Fletcher and the binary choice form of applicant's invention to perform equally well in receiving user's input. Therefore, it would have been prima facie obvious to modify Fletcher to obtain the invention as specified in claim 9-10, 15 and 18 because such modification would

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have been considered a mere design consideration which fails to patentably distinguish over the prior art of Fletcher.

9. **Claim 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Singer US 6,557,009 and Allison US 6,546,230.**

Claim 20: The Singer reference fails to provide a teaching of displaying a deficiency macro to said assessed user, via said graphical user interface, when one of said plurality of responses to the subset of evaluation/assessment question comprising at least one of said plurality of assessment courses is indicative of “No”. However, the Allison reference provides a teaching of displaying a deficiency macro to said assessed user, via said graphical user interface, when one of said plurality of responses to the subset of evaluation/assessment question comprising at least one of said plurality of assessment courses is indicative of “No” (see col. 10:30-45 and FIG. 7). Therefore, it would have been obvious to include the feature of displaying a deficiency macro to said assessed user, via said graphical user interface, when one of said plurality of responses to the subset of evaluation/assessment question comprising at least one of said plurality of assessment courses is indicative of “No”, as taught by Allison, in order to inform the assessed user which area that the user need to concentrate in order to qualify for the certification (see col. 10:40-45).

Response to Arguments

Applicant's arguments with respect to claim 06/12/2008 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT J. UTAMA whose telephone number is (571)272-1676. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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